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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 18

Application Number: 09/074,544
Filing Date: 05/08/98
Appellant(s): Meyer et al.

Andrew J. Bateman
For Appellant

EXAMINER'S ANSWER

MAILED
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Technology Center 2100

This is in response to appellant's supplemental brief on appeal filed on 8/17/01.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is substantially correct. Minor changes is as follow:

Claims 1-5, 16-28, 39-45, 60-61 are rejected under 35 U.S.C. 103(a). Claims 6-15, 29-38, 46-59 are rejected under 35 U.S.C. 102(e).

Claims 2-23, 25-61 form the basis for the appeal. Claims 1 and 24 are not on appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that the claims stand or fall together as separate groups and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The appellants further stated that the remaining claims, i.e., claims 6-7,9,13-14,29-30,32,36-37,46-47,49,53-

54,57,58, and 2-5,16-23,25-28,39-45,60-61, stand or fall together as a group however

provided two different arguments for the claims.

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims

under appeal.

6,055,544	DeRose et al	4/2000
5,848,410	Walls et al	12/1998

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-15, 29-38, 46-59 are rejected under 35 U.S.C. 102(e). Claims 2-5, 16-

23, 25-28, 39-45, 60-61 are rejected under 35 U.S.C. 103(a). These rejections are set forth in

prior Office action, Paper No. 8.

(11)   Response to Argument

The DeRose reference. The DeRose reference relates to electronic publishing of

electronic documents. Specifically, the retrieving and displaying of electronic documents over

World Wide Web (col. 1, line 44 - col. 2, line 33). On WWW information is presented to the

user as a collection of documents. A site on a network which electronically publishes

documents on the WWW documents is call a Web site (col. 2, lines 34-40). A Web site

contains a group of related HTML documents. Web browser allows the user to retrieve and

display one or more selected document from the table-of-contents of related documents (col. 2,

line 66 - col. 3, line 45). Electronic documents can be a simple short text or as large as

operation manuals for large systems (col. 8, lines 12-19). Very large documents, such as the

operation manuals for large system, are equivalent to a help folder containing a hierarchy of

sub-folders and files. The manual includes volumes, chapters, section, and paragraphs (col.

18, lines 65-67), which are equivalent to books and files within the operation manual folder.

Figure 3 discloses a large document folder which contains books and files (col. 8, lines 13-

46). The appellants also admit that DeRose teaches a document folder broken down into a

hierarchy of books, chapters, pages...(Brief's page 6, 2nd par.). DeRose's document

hierarchy is similar to the appellants' figure 2. The DeRose reference directs to the retrieving

and displaying of any selected portion of a document from a group of related documents in an

operation manual help folder. Conventionally, when any document selected from the listed

documents is retrieved from a server by a client, the entire document is loaded into the client's

memory. There is no protocol which allows access only a portion of the document. If the selected document is very large, the user must wade through irrelevant information to reach a desired portion of the document (col. 3, lines 46-67). DeRose solves the prior art problem by scanning (hierarchical indexing) the selected document to generate a table-of-contents for the document, from which a selected portion of a document may be rendered (col. 14, lines 40-53; col. 17, line 60 - col 19, line 58).

As for claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57-58: The appellants argue that DeRose does not teach the claimed limitation "indexing each file and a first level of each book of a predetermined folder for a files of a first type", it appears that the appellants are equating DeRose's teaching of "very large operation manual" as a single book instead as a help folder containing a hierarchy of sub-folders of books and files. DeRose teaches a full text indexing, called a hierarchical indexing, for scanning the entire operation manual for frequency occurrences of words found in each element and sub-element of all level of a document, i.e., the operation manual (col. 10, line 54 - col. 11, line 26. See also the incorporated by reference application 07/733,204, now patent 5,557,722, col. 13, line 1 - col. 15, line 36). Thus DeRose clearly teach the indexing of each file and book of the operation manual folder for files of a first type. A table of content is then generated from which a section of a document may be selected (col. 11, lines 38-53).

The appellants argue that DeRose' table of content is not generated "after" the indexing for files of a first type. DeRose discloses that the table-of-contents indicates the number of

occurrences of words based on the full text index (col. 11, lines 48-51). Thus it is clear that

the table-of-content is generated after the full text indexing.

Based on the same rationale that DeRose's teaching is within a single document only,

the appellants further argue that DeRose does not teach the scanning "separated, individual

files" for HTML tags. As set forth above, the operation manual is a help folder which

contains a group of documents represented by volumes, chapters, sections, files... Per

DeRose, each separate document of the operation manual (volume, chapter, section, file...) is

scanned for HTML tags to generate the table of contents (col. 11, lines 18-21; col. 15, line 1 -

col. 19, line 35). In the examples given in figures 9 and 10 (col. 11, lines 46-53), a table-of-

content is generated dynamically for any input word. The examples indicate that every

separate individual document in the operation manual is scanned for HTML tags. Since the

table-of-content can be generated dynamically for every input word, the appellants' argument

that the table-of-content must be manually updated, therefore, is not persuasive.

As for claims 8,31,48: The appellants argue that DeRose does not teach the claimed

"Creator designation". While applicant may be his or her own lexicographer, a term in a

claim may not be given a meaning repugnant to the usual meaning of that term. See *In re*

Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Claims must be given broadest reasonable

interpretation. Although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Thus the term "creator designation" in claim 8 can be

reasonably interpreted as any marker, identifier, name, specifier, or indicator arbitrarily created by an author for the purpose of designation. DeRose's disclosure includes creator designations such as file name (col. 11, line 31 - col. 12, line 27) and *"http://www.ebt.com/pro/abook#EID(13)"*.

As for claims 10, 33 and 50: Based on the same rationale that DeRose's teaching is within a single document only, the appellants further argue that DeRose does not teach the generating a table of contents based on a multi-file system. As set forth above, DeRose's operating manual help folder is a multi-file system wherein each file (volume, chapter, section, paragraph) within the folder is scanned for generating the table of contents (col. 10, line 54 - col. 11, line 26. See also the incorporated by reference application 07/733,204, now patent 5,557,722, col. 13, line 1 - col. 15, line 36).

As for claims 11, 34, 51: In response to the argument that DeRose does not teach the HTML template for generating the table of contents, figure 12A and the examples given in column 15, lines 1-20 showing table-of-contents formatted according to an HTML template.

As for claims 12, 35, 52: Claim 12 recites the providing of the table-of-contents in response to a request. The appellants appear to narrowly interpret the limitation "a request" as a request made by a user. Such interpretation is not supported by the language of the claim. The request could be an instruction generated directly or indirectly, upon receipt of a user selection of an element, as is disclosed in col. 18, lines 57-59, upon receipt of a user selection of a document (patent 5,557,722, col. 5, lines 63-64, incorporated by reference). It should be

noted that the element or the document could be the operation manual folder. The table-of-content may also be generated in response to a user selection of the "Table-of-contents" option (figure 10, lower right corner).

As for claims 15, 38, 59: Claim 15 recite the step determining whether a table-of-contents needed to be generated in repose to the user selection of the help system. DeRose discloses the determination whether a table-of-contents needed to be generated in response to the user selection of an element of the operation manual. The element can be a document within the manual or the manual itself. If the selected element is too large then a table of content is generated (col. 13, lines 12-30). The appellants argue that DeRose teaches the displaying but not the generating the table-of-content. The argument is not persuasive since the table-of-contents must be generated so that it can be visualized on the display. Furthermore, DeRose's objective is generating table-of-content for large document to avoid the loading of the entire document.

As for claims 55, 56: In response to the argument that DeRose does not use a template for creating the table-of-contents, the template is disclosed in figure 12A (col. 12, lines 34-61) for converting from SGML to HTML. Without the conversion it would appear that the table-of-content can not be created. Thus the step determining whether the template exist is implicitly included in DeRose.

The Walls et al reference. In the same field of retrieving document in large database, Walls teach a method for quickly locate desired document without generating references to

undesired documents. The method include index generator to continuously scanning HTML

tags of all files within a file system to form an index for the file system. The index is updated

hourly or daily (see Summary of the Invention).

As for claims 2-5, 16-23, 25-28, 39-45, and 60-61: Claims 2-5, 16-23, 25-28, 39-45,

and 60-61 stand or fall together as a group. Broadest claim 41 recites the generating of an up-

to-date table-of-contents in response to the activation of an information system. As set forth

above, the table-of-content can be generated upon receipt of a user selection of an element

(col. 18, lines 57-59), upon receipt of a user selection of a document (patent 5,557,722, col.

5, lines 63-64, incorporated by reference). It should be noted that the element or the

document could be the operation manual folder. The table-of-content may also be generated in

response to a user selection of the "Table-of-contents" option (figure 10, lower right corner).

DeRose fails to clearly teach that the table-of-content is up-to-date. However, generating of

up-to-date table of content is disclosed by Walls et al (Walls' col. 13, lines 17-45). It would

have been obvious to one of skilled in the art, at the time the invention was made, to combine

Walls' teaching of generating an up-to-date table-of-content to DeRose. Motivation of the

combining is for updating the table-of-contents. The appellants continue to argue that

DeRose's invention directs to the generating of table-of-contents for a single file only thus can

not be combine with Walls' multi-file system. As set forth above, DeRose's teaching of large

operation manual having volumes, chapters, sections is equivalent to a help folder having

separate files and books. The argument, therefore, is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Huynh-Ba
October 19, 2001

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